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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			KANG, INSUN	
			ART UNIT	PAPER NUMBER
			2124	

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/772,905

Applicant(s)

HARUKI, KOSUKE

Examiner

Insun Kang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is in response to the amendment filed 4/29/2004.
2. As per applicant's request, claims 1-6 and 8-11 have been amended and claims 12-14 have been added. Claims 1-14 are pending in the application.

### ***Claim Objections***

3. The objections to claims 1, 3 and 4 have been withdrawn due to the amendment to the claims.
4. Claims 1, 8, 10, objected to because of the following informalities: The underline or strike through is not used properly in the amended claims: 1) Per claim 1, in line 12, ":", in the phrase of "based on the determination result; and issuing" 2) per claim 8, in line 9, ":", in the phrase of "license data, before transferring" 3) per claim 10, in line 10, ":", in the phrase of "electronic device; and" 4) are newly added punctuations. Therefore proper use of underline/strike-through is required.

As per claims 2-7, 9, 12 and 13, these claims are objected for dependency on the above rejected parent claims 1, 8, 10. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 1-7 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "controlling permission or inhibition of issuing the license data" and further recites, "issuing the license data." In the case it is determined to be inhibited, the license data cannot be issued. Therefore, the claim is indefinite. Appropriate correction is required.

As per claims 2-7 and 12, these claims are rejected for dependency on the above rejected parent claim 1.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Story, Jr. et al. (US Pub. No. 2002/0046181), hereinafter referred to as "Story" Jones et al. (US Patent 6,697,944) hereinafter referred to as "Jones."

Per claim 1:

- contents-processing software for downloading contents data from a computer to an electronic device in a state in which the computer is

connected to the electronic device ("Playback device interface... allows computer system... to communicate licensing information, digital content, and other data to and receive data from a mobile playback device," page 2 paragraph 0021 and 0031)

- determining, by the electronic device, upon receiving an acquisition request of license data necessary for installing the software or downloading contents from the computer to the electronic device by the software, whether or not license data is issued by referring to management data indicating issue status of license data, stored in a memory in the electronic device ("one or more license management devices that manage licenses for playback of digital content. The license management devices create licenses having an associated cardinality that determines the number of playback devices that can be authorized by the license. The license is stored in a set of playback devices, where the number of playback devices in the set is less than or equal to the cardinality of the license," pg 1, paragraph 0016; The license is stored in a set of one or more playback devices at 630... the license management device issues a command to one or more specific playback devices. The command includes a player identifier for each of the one or more players targeted and is encrypted and digitally signed by the license management device. The license is stored in the playback device if the command originates from an authorized source and includes the identifier of the playback device. Alternatively, the license can be stored in the set of

playback devices in another manner," pg 4, paragraph 0050; see also abstract; pg 3, paragraph 0043; Fig 6)

- controlling permission or inhibition of issuing the license data stored in the memory in the electronic device based on the determination result ("When a playback device receives digital content, the playback device checks the digital content for a license that matches the license stored in the playback device. If the licenses match, the playback device is authorized to, and is enabled to, play the digital content, which includes decrypting the digital content if necessary. Otherwise the playback device does not play the digital content," pg 3, paragraphs 0041 and 0042; Fig 6)

Story does not explicitly teach issuing the license data to the computer before transferring the contents data. However, Jones teaches it was known in the art of software installation and distribution, at the time applicant's invention was made, to ensure digital content file protection by preventing unauthorized distribution such as those disclosed in Jones ("Once the device identity and level of trust haven been established, the downloading of the digital content file may proceed...The authentication module...thereafter enforces the digital rights management ...within portable device...by preventing the file system...from copying the protected files," col. 12 lines 30-47). It would have been obvious for one having ordinary skill in the art of software installation and distribution to modify Story's disclosed system to issue the license data to the computer before transferring the digital contents data so that the contents data cannot be transferred to the playback device if license data has already been issued. The

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modification would be obvious because one having ordinary skill in the art would be motivated to prevent illegal digital content files transfer to playback devices as suggested by Jones (col. 12 lines 30-47).

Per claim 12:

The rejection of claim 1 is incorporated, and further, Story teaches an internal memory which cannot be accessed by a user or a file system of the computer ("Player ...includes a processor and internal random access memory(RAM), read only memory (ROM) and a memory storage device such as flash memory," page 2 paragraph 0032) as claimed.

Per claim 2:

The rejection of claim 12 is incorporated, Story further discloses:

*-the control step controls to issue the license data to the computer when the determination result indicates that the license data has not been issued, and to inhibit the issuance of the license data when the determination result indicates that the license data has been issued* ("When a playback device receives digital content, the playback device checks the digital content for a license that matches the license stored in the playback device. If the licenses match, the playback device is authorized to, and is enabled to, play the digital content, which includes decrypting the digital content if necessary. Otherwise the playback device does not play the digital content," pg 3, paragraphs 0041 and 0042; Fig 6) as claimed.

Per claim 3:

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The rejection of claim 12 is incorporated, Story further discloses *ID data for identifying a computer which has issued the license data is registered as the management data in the memory and permission or inhibition of issuing the license data for the acquisition request is determined by the controller of the electronic device, on the basis of whether the ID data has not been registered and whether the ID data is coincident with ID data of the computer which has issued the acquisition request* ("In one embodiment, the license comprises a 32 bit group identifier... Thus, each playback device storing a license belongs to a set of one or more playback devices storing the license. The set of playback devices is authorized to play digital content that includes the license," pg 3, paragraph 0043, see also pg 2, paragraphs 0027, 0041, 0042 and 0050) as claimed.

Per claim 4:

The rejection of claim 12 is incorporated, Story further discloses:

*-plurality of memory areas for registering a plurality of ID data are created in the memory* ("Playback devices can store multiple licenses, which allows playback devices to belong to multiple sets of playback devices authorized to playback various digital content,"pg 2, paragraphs 0032; " The license is stored in a set of one or more playback devices at 630... the license management device issues a command to one or more specific playback devices. The command includes a player identifier for each of the one or more players targeted and is encrypted and digitally signed by the license management device. The license is stored in the playback device if the command originates from an authorized source and

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includes the identifier of the playback device. Alternatively, the license can be stored in the set of playback devices in another manner," pg 4, paragraph 0050) as claimed.

Per claim 5:

The rejection of claim 2 is incorporated, Story further discloses:

*-returning a content of the management data to a state preceding issue of the license data in response to an uninstall notification of the software that is issued from the computer to the electronic device* ("In one embodiment license management device 510 is necessary to either add or remove licenses from a playback device. Thus, license management device 510 can be used to provide centralized license management," pg 4, paragraph 0047) as claimed.

Per claim 6:

The rejection of claim 12 is incorporated, Story further discloses:

*-the electronic device includes a contents playback device for recording and playing back contents transferred from the computer, and the software has a function of managing contents transfer to the electronic device* ("The present invention relates to digital information playback. More particularly, the present invention relates to management of licenses for playback of digital information," pg 1, paragraph 0001; " In one embodiment, the present invention is related to the use of computer system 100 to provide, manage and/or receive licenses for digital content playback devices," pg 1, paragraph 0022; "Software players are software entities executed by computer systems that use the computer system

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memory to store the digital content and the computer system A/V capabilities to play the digital content,” pg 1, paragraph 0003) as claimed.

Per claim 7:

The rejection of claim 6 is incorporated. Story further discloses the software uses license data in the electronic device to perform authentication of whether the electronic device is rightful, and when authentication succeeds, transfers contents to the electronic device (“Playback devices that have a license that matches a license included in the digital content are authorized to play the digital content. In one embodiment a single license can be used to provide authorization to play digital content from multiple sources and/or multiple types of content. Playback devices can store multiple licenses, which allows playback devices to belong to multiple sets of playback devices authorized to playback various digital content,” pg 1, paragraph 0017; “The license is also communicated to content provider 520 by license management device 510. In one embodiment content provider 520 embeds the license in digital content for which the owner of the playback device is authorized to play,” pg 4, paragraph 0050; “When a playback device receives digital content, the playback device checks the digital content for a license that matches the license stored in the playback device. If the licenses match, the playback device is authorized to, and is enabled to, play the digital content, which includes decrypting the digital content if necessary. Otherwise the playback device does not play the digital content,” pg 3, paragraph 0041) as claimed .

As per claim 8, Story discloses an electronic device capable of recording or playing back contents downloaded from a computer, comprising means for storing license data necessary for installing software for contents transfer from the computer to a contents playback device, or executing a specific function of the software, and management data for managing an issue history of the license data ("A method and apparatus for digital content license management is disclosed that provides one or more license management devices that manage licenses for playback of digital content," abstract; "Playback device interface 130 allows computer system 100 to communicate licensing information, digital content, and other data to and receive data from a mobile playback device," pg 2, paragraph 0021-22; "Player 400 is a mobile playback device that allows digital content to be downloaded, for example, via a playback device interface a played back later. A user can utilize the buttons on player 400 to navigate through stored data to replay desired digital content," Pg 2, paragraph 0031; see also pg 2, paragraph 0021); means for, upon reception of a license data acquisition request from a computer connected to the contents playback device, determining permission or inhibition of issuing the license data on the basis of the management data ("one or more license management devices that manage licenses for playback of digital content. The license management devices create licenses having an associated cardinality that determines the number of playback devices that can be authorized by the license. The license is stored in a set of playback devices, where the number of playback devices in the set is less than or equal to the cardinality of the license," pg 1, paragraph 0016; The

license is stored in a set of one or more playback devices at 630... the license management device issues a command to one or more specific playback devices. The command includes a player identifier for each of the one or more players targeted and is encrypted and digitally signed by the license management device. The license is stored in the playback device if the command originates from an authorized source and includes the identifier of the playback device. Alternatively, the license can be stored in the set of playback devices in another manner," pg 4, paragraph 0050; see also abstract; pg 3, paragraph 0043; Fig 6).

Story does not explicitly teach determining permission or inhibition of issuing the license data **before transferring the contents**. However, Jones teaches it was known in the art of software installation and distribution, at the time applicant's invention was made, to ensure digital content file protection by preventing unauthorized distribution such as those disclosed in Jones ("Once the device identity and level of trust haven been established, the downloading of the digital content file may proceed... The authentication module ...thereafter enforces the digital rights management ...within portable device...by preventing the file system...from copying the protected files," col. 12 lines 30-47). It would have been obvious for one having ordinary skill in the art of software installation and distribution to modify Story's disclosed system to determine to issue the license data to the computer before transferring the digital contents data so that the contents data cannot be transferred to the playback device if license data has already been issued. The modification would be obvious because one

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having ordinary skill in the art would be motivated to prevent illegal digital content files transfer to playback devices as suggested by Jones (col. 12 lines 30-47).

Per claim 13:

The rejection of claim 8 is incorporated, and further, Story teaches an internal memory which cannot be accessed by a user or a file system of the computer ("Player ... includes a processor and internal random access memory(RAM), read only memory (ROM) and a memory storage device such as flash memory," page 2 paragraph 0032) as claimed.

Per claim 9:

The rejection of claim 13 is incorporated, Story further discloses:

*-returning a content of the management data to a state preceding issue of the license data in response to an uninstall notification of the software that is issued from the computer to the electronic device ( "In one embodiment license management device 510 is necessary to either add or remove licenses from a playback device. Thus, license management device 510 can be used to provide centralized license management," pg 4, paragraph 0047) as claimed.*

As per claim 10, Story discloses a procedure of, in installing the computer program or executing a specific function of the computer program, requesting acquisition of license data of an electronic device which stores license data necessary for installing the computer program or execution the specific function, an management data for managing an issue history of the license data ("A

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method and apparatus for digital content license management is disclosed that provides one or more license management devices that manage licenses for playback of digital content,” abstract; “Playback device interface 130 allows computer system 100 to communicate licensing information, digital content, and other data to and receive data from a mobile playback device,” pg 2, paragraph 0021-22; “Player 400 is a mobile playback device that allows digital content to be downloaded, for example, via a playback device interface a played back later. A user can utilize the buttons on player 400 to navigate through stored data to replay desired digital content,” Pg 2, paragraph 0031; see also pg 2, paragraph 0021); a procedure of permitting the install or the execution of the specific function on a condition that rightful license data is acquired from the electronic device; (“one or more license management devices that manage licenses for playback of digital content. The license management devices create licenses having an associated cardinality that determines the number of playback devices that can be authorized by the license. The license is stored in a set of playback devices, where the number of playback devices in the set is less than or equal to the cardinality of the license,” pg 1, paragraph 0016; The license is stored in a set of one or more playback devices at 630... the license management device issues a command to one or more specific playback devices. The command includes a player identifier for each of the one or more players targeted and is encrypted and digitally signed by the license management device. The license is stored in the playback device if the command originates from an authorized source and includes the identifier of the

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playback device. Alternatively, the license can be stored in the set of playback devices in another manner," pg 4, paragraph 0050; see also abstract; pg 3, paragraph 0043; Fig 6).

Story does not explicitly teach that the license data is sent to the computer program before the install or the execution of the specific function.

However, Jones teaches it was known in the art of software installation and distribution, at the time applicant's invention was made, to ensure digital content file protection by preventing unauthorized distribution such as those disclosed in Jones ("Once the device identity and level of trust haven been established, the downloading of the digital content file may proceed... The authentication module ...thereafter enforces the digital rights management ...within portable device...by preventing the file system...from copying the protected files," col. 12 lines 30-47). It would have been obvious for one having ordinary skill in the art of software installation and distribution to modify Story's disclosed system to send the license data to the computer program before the install or the execution of the specific function so that the contents data cannot be transferred to the playback device if license data has already been issued. The modification would be obvious because one having ordinary skill in the art would be motivated to prevent illegal digital content files transfer to playback devices as suggested by Jones (col. 12 lines 30-47).

As per claim 11, it is the license management method version of claim 10, respectively, and is rejected for the same reasons set forth in connection with the rejection of 10 above.

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Per claim 14:

The rejection of claim 11 is incorporated, and further, Story teaches an internal memory which cannot be accessed by a user or a file system of the computer ("Player ...includes a processor and internal random access memory(RAM), read only memory (ROM) and a memory storage device such as flash memory," page 2 paragraph 0032) as claimed.

### ***Response to Arguments***

9. Applicant's arguments filed 4/29/2004 have been fully considered but they are not persuasive.

Per claim 1:

The Applicant states that Story fails to teach, describe or suggest:

"determining...whether or not license data is issued by referring to management data indicating issue status of license data." As explained in the specification, the licensed data and management data may be used to limit the use of the software...This feature can help in preventing a user from installing the software in a plurality of personal computers exceeding the range permitted by the license. In contrast, Story fails to teach, describe or suggest, "determining...whether or not license data is issued by referring to management data indicating issue status of license data (page 7 last paragraph – page 8 lines 1-2)."

The applicant simply states that Story does not teach, describe or suggest the limitations in the claim and fails to show why the limitations in the instant claim are different from the teachings of the reference and why Story fails to teach, describe or suggest the limitations. Also, the examiner points out that Story discloses determining ...whether or not license data is issued by referring to

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management data indicating issue status of license data ("one or more license management devices that manage licenses for playback of digital content. The license management devices create licenses having an associated cardinality that determines the number of playback devices that can be authorized by the license. The license is stored in a set of playback devices, where the number of playback devices in the set is less than or equal to the cardinality of the license," pg 1, paragraph 0016; pg 4, paragraph 0050; see also abstract; pg 3, paragraph 0043; Fig 6).

Therefore, the rejection of claim 1 concerning the limitation "determining... whether or not license data is issued by referring to management data indicating issue status of license data" is considered proper and maintained.

The Applicant states:

Story fails to disclose a license management method that can inhibit the transfer of digital content as recited in amended claim 1. Instead, the digital content in Story is always received by the playback device. The playback device simply checks to see whether the license stored in the transferred digital content matches the license contained in the playback device before playing the content. Amended claim 1 is patentably distinguishable from Story in that it recites, among other things, "issuing the license data to the computer before transferring the contents data." Story fails to teach, describe or suggest, at least this subject matter of claim 1.

Applicant's arguments with respect to the newly added limitation, i.e. issuing the license data to the computer before transferring the contents data have been considered but are moot in view of the new ground(s) of rejection.

Per claims 8:

Applicant states:

Independent claim 8 is also patentably distinguishable from Story because it recites for example "storing... management data for managing an issue history of the license data."

The examiner points out:

1) The applicant simply states that claim 8 is also patentably distinguishable from Story and fails to show why the limitations in the instant claim are different from the teachings of the reference and why Story fails to teach, describe or suggest the limitations. 2) Furthermore, Story discloses "storing... management data for managing an issue history of the license data" and "determining permission or inhibition...on the bases of the management data" (pg 2, paragraph 0021-22; Pg 2, paragraph 0031; see also pg 2, paragraph 0021; "The license is stored in a set of playback devices, where the number of playback devices in the set is less than or equal to the cardinality of the license," pg 1, paragraph 0016; The license is stored in a set of one or more playback devices at 630... the license management device issues a command to one or more specific playback devices. ... The license is stored in the playback device if the command originates from an authorized source and includes the identifier of the playback device," pg 4, paragraph 0050; see also abstract; pg 3, paragraph 0043; Fig 6) as addressed above.

Therefore, the rejection of claim 8 concerning the limitation  
"determining...whether or not license data is issued by referring to management

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data indicating issue status of license data" is considered proper and maintained.

As has been shown above, the rejection of the claim 1 regarding the newly added limitation, "...issuing the license data...before transferring the contents data" is moot in view of the new ground(s) of rejection. Accordingly, the rejection of claim 8 regarding the limitation is also moot.

Per claims 2-7, 9, 12 and 13:

The applicant states that claims 2-7, 9, 12 and 13 are allowable as being dependent on allowable base claims 1 and 8. As has been shown above, the rejections of the independent claims 1 and 8 by Story and Jones are proper, the argument that claims 2-7, 9, 12 and 13 are allowable, as being dependent on an allowable base claim is considered moot. Accordingly, the rejections of claims 2-7, 9, 12 and 13 are proper.

Applicant's arguments with respect to claims 10, 11 and 14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Insun Kang whose telephone number is 703-305-6465. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on 703-305-9662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IK  
7/27/2004

*Kakali Chaki*

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